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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,679	12/01/2003	Erning Xia	P03294	2369

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EXAMINER	
ROGERS, JAMES WILLIAM	
ART UNIT	PAPER NUMBER
1618	
MAIL DATE	DELIVERY MODE
02/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/724,679	XIA ET AL.	
	Examiner	Art Unit	
	JAMES W. ROGERS	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,6,10,12,15,19,24,25,30,31 and 33-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,6,10,12,15,19,24-25,30-31 and 33-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1,3,6,10,12,15,19,30-31 and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howes (US 4,504,405) in view of Ogunbiyi et al. (US 4,758,595), for the reasons set forth in the office action filed 09/12/2007.

Claims 1,3,6,10,12,15,19,24-25,30-31 and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howes (US 4,504,405) in view of Ogunbiyi et al. (US 4,758,595) in view of Vehige et al. (US 5,858,346).

A new rejection of claims 10 and new claims 35-38 was necessitated by applicant's amendment.

The new limitations within claims 10 and 35-38 are met by the references above because Howes most preferably contained from 0.25 to 1.0 %, for example 0.5 percent, these amounts are within applicants claimed range.

Response to Arguments

Applicant's arguments filed 12/28/2007 have been fully considered but they are not persuasive. Applicants assert the examiner has used impermissible hindsight in his

rejection because one skilled in the art first must pick the poloxamers out of a list of other surfactants disclosed in Howes, then secondly pick the one out of five poloxamers with an HLB value less than 7 and thirdly combine Pluronic L62 with the other Pluronic but not Pluronic L64 because this has an HLB of 15. Applicants then submit that the combination would not have yielded predictable results to one skilled in the art and there is no hint of suggestion or motivation in the art to combine. Applicants also assert that because Howes discloses that Pluronic L64 is the preferred polaxomer this teaches away from applicants claimed invention.

Firstly Howes describes numerous surfactants with HLB values of greater than 18 including Myrjjs, Brijs and Tweens, all of these surfactants as detailed within applicants specification have an HLB value higher than 18. Secondly it would have been obvious to combine more than one surfactant in the same composition since they are all used for the same purpose and their combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention, as such surfactants are known to be equivalent as taught in the art. Thirdly it is also obvious that since Ogunbiyi discloses the use of Polaxamine 1107 a surfactant with an HLB of more than 18 it could be combined with the surfactants disclosed within Howes including Pluronic L62. A person of ordinary skill has good reason to pursuer the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. Regarding applicants assertion that Howes teaches away from their claimed surfactant having an HLB value of less than 12 because Pluronic L64 is preferred, once again Pluronic L64 even though preferred is

not the only embodiment as to what Pluronics can be used and clearly Howes describes the use of Pluronic L62 which meets applicants claimed invention. Even though L62 is just one of five Pluronics does not mean that the use of Pluronic L62 is not described. The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Regarding applicants assertion that there is no motivation or suggestion to combine, the recent court in KSR International Co. v.Teleflex Inc. (KSR), 550 U.S. ___, 82 USPQ2d 1385 (2007), clearly stated as applicants are aware while teaching, suggestion or motivation is still a valid reasoning for an obviousness rejection it is not the only reasoning the examiner may apply for an obviousness refection. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a). As clearly put forth in the previous office action applicants claimed contact lens solution would have been *prima facie* obvious from the combination of the ingredients within the references above because

the substitution of known elements for another known element would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618